REMARKS/ARGUMENTS

I. Summary of the Office Action

Claims 1-77 are pending in this application. The Examiner rejected Claims 18-28, 38-44, 53-59, 65-67, 73-75 and 77. The Examiner Withdrew Claims 1-17, 29-37, 45-52, 60-64, 68-72 and 76

The Examiner rejected Claims 18, 19, 23, 38, 53, 65, 73, 77 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner rejected Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 under 35 U.S.C. 101 as lacking patent utility. The Examiner rejected Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-20 of U.S. Patent No. 7,016,872 (hereinafter, "Bettis").

II. Summary of Applicants Reply

Applicants respectfully submit that no new matter has been introduced into the subject application. Specifically, the amendment to Claims 18, 19, 23, 38, 53, 65, 73, and 77 are supported by the original specification and drawings, for example, as discussed below in greater detail. Further, new Claims 78-83 are supported by the original specification and drawings, for example, as discussed below in greater detail.

The Examiner's rejections are respectfully traversed below.

Reconsideration of the present application is respectfully requested.

III. The rejection of Claims 18, 19, 23, 38, 53, 65, 73, 77 under 35 U.S.C. 112

The Examiner rejected Claims 18, 19, 23, 38, 53, 65, 73, 77 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants have amended the Claims 18, 19, 23, 38, 53, 65, 73, 77 to more particularly point out and distinctly claim the subject matter which the applicants regard as the invention. For example, as amended, Claim 18 recites:

> A method of evaluating an analyst's performance, comprising:
> utilizing information pertaining to at least one of an upward revision and a downward revision of an analyst's opinion of at least one investment:
> calculating a performance score indicative of the analyst's performance relative to other analysts, said performance score determined by at least one of measuring variability of the analyst's performance based on at least one of an upward revision and downward revision, averaging historical performance of the at least one investment following the at least one upward revision and downward revision, determining a number based on at least one of an upward revisions and downward revisions made by the analyst, and determining a likelihood that at least one upward revision and downward revision will actually produce an expected result; and
> comparing the analyst's performance score against performance scores of other analysts to produce at least one of an upward ranking, a downward ranking, and a combined revision ranking.

Specifically, the Examiner stated that:

> the claim language is not sufficiently clear for one of ordinary skill in the art to know what is considered an 'upward or downward revision' . . . it is not clear whether the 'revision' must necessarily include an upward or downward change in opinion, or if the information pertains to the revision and includes an upward or downward change in opinion.

The applicants have amended Claim 18 reciting "utilizing information pertaining to at least one of an upward revision and a downward revision of an analyst's opinion of at least one investment." As amended, Claim 18 indicates that there may be one of an upward revision and a downward revision by an analyst. That is, an analyst may state one of an upward revision or a downward revision. Further, for example, an upward revision and downward revision is defined in, at least, the background section of this application reciting:

> During the course of providing investment advice, each analyst may make any number of upward and/or downward forecast revisions on securities in their area of expertise. The forecast revisions, or simply revisions, are changes in opinion on how much a company is likely to earn per share.

The Examiner stated that: "the word 'considering' renders the Claim indefinite because 'considering' does not clearly define the subsequently listed measurements are used at all in the calculation." The applicants have amended Claim 18 **removing** the word "considering" and including the words "by at least one of." As amended Claim 18 recites:

> calculating a performance score indicative of the analyst's performance relative to other analysts, said performance score determined by at least one of

The Examiner stated that: "a standard deviation requires that the 'revision' be numerical." Applicants respectfully disagree. However, applicants have removed the reference to standard deviation from all independent claims. Further applicants have amended new Claims 78-83 defining calculating a performance score to further include determining a standard deviation. For example, dependent Claim 78 recites:

> The method of Claim 18, wherein calculating a performance score further comprises determining a standard deviation based on at least one upward revision and downward revision.

For at least the aforementioned reasons discussed relevant to claim 18, amended independent claims 38, 53, 65, 73, and 77 should also be allowed. Accordingly, for at least these reasons, applicants respectfully request that this rejection be withdrawn.

The Examiner rejected Claim 19 as having insufficient antecedent basis for the phrase "said three distinct periods of time." Applicants have amended Claim 19 to provide sufficient antecedent basis. Further, the Examiner stated that "the word approximately is indefinite." The applicants have amended Claim 19, further defining the three distinct periods of time replacing the term "approximately" with the term "about." That is, the word "about" is allowable with, for example, reference to time. See, W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540; 220 USPQ 303 (Fed. Cir. 1983). As amended Claim 19 recites:

> The method of Claim 18, wherein determining at least on of the analyst's performance and performance score is determined based on at least one of three distinct periods of time comprising a short period of time which is about five days, an intermediate period of time which is about twenty days, and a long period of time which is about sixty days.

The Examiner stated that in "Claim 23, the modifier 'small' is a relative term, and does not clearly define the return penalty." Applicants have removed the term small from Claim 23. Applicants have also amended Claim 24, depending from Claim 18, removing the term small. Further, return penalty is defined in, at least, the description of the application on, for example, page 33, lines 0-19. As amended Claim 23 recites:

> The method of Claim 18, further comprising adjusting said performance score according to a return penalty.

Accordingly, for at least these reasons, applicants respectfully request that this rejection be withdrawn.

IV. The rejection of Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 under 35 U.S.C. 101

The Examiner rejected Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 under 35 U.S.C. 101 as lacking patent utility. Applicants have amended the Claims 18, 19, 23, 24, 38, 53, 65, 73, and 77 to better define the patent utility. Further applicants wish to state that the claims are directed towards, for example, evaluating an analyst's performance. As pointed out in the background, obtaining advice of analysts has always been considered a prudent exercise. Further, evaluating an analysts performance is a significantly more prudent exercise. Applicants respectfully wish to point out that a large portion of the economy is driven by analyst opinions. Evaluating analyst's revisions is useful and produces a concrete and tangible result.

Accordingly, for at least these reasons, applicants respectfully request that this rejection be withdrawn.

V. The rejection of Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 on the ground of nonstatutory obviousness-type double patenting

The Examiner rejected Claims 18-28, 38-44, 53-59, 65-67, 73-75, and 77 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-20 of Bettis. Applicants will file a Terminal Disclaimer resolving the nonstatutory obviousness-type double patenting rejection upon the indication of allowable subject matter.

Accordingly, for at least these reasons, applicants respectfully request that this rejection be withdrawn.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing

over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

Docket No.: 26119.120US1
Serial No. 09/829,439

PATENT

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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